

REMARKS

Restriction Requirement

Applicants herein acknowledge the restriction requirement in the above-referenced application. Claims 1 through 26 are currently pending in the application. The Office has identified the following groups of claims as being drawn to separate inventions:

Group I – claims 1-19, drawn to method of playing a pari-mutuel wagering game, affording a plurality of game participants an opportunity to place a wager on one or more of the plurality of potential outcomes and to specify an odds level of a plurality of progressive odds levels at which the wager is accepted; classified in class 463, subclass 028; and

Group II – claims 20-26, drawn to method of playing a pari-mutuel wagering game, setting an initial share price for each of the plurality of potential outcomes; affording a plurality of game participants an opportunity to purchase at least one share in favor of at least one outcome of the plurality of potential outcomes at the initial share price; determining an adjusted share price for each of the plurality of potential outcomes; affording the plurality of game participants an opportunity to purchase at least one share in favor of the at least one outcome of the plurality of potential outcomes at the adjusted share price; classified in class 705, subclass 35.

Applicants hereby elect the claims of Group I, claims 1-19, with traverse in order to preserve their right of petition.

A Restriction Requirement is improper at the current stage of prosecution for this Application, namely after final action and after appeal. A restriction requirement “may be made at any time *before* final action.” 37 CFR 1.142(a), second sentence; see also M.P.E.P. § 811. The M.P.E.P. herein clearly indicates that a restriction requirement may not be made *after* final action. In this case, a Final Office Action was mailed April 4, 2008, and Applicants filed an appeal, including an appeal brief that was submitted to the Office on December 8, 2008. The present Restriction Requirement was issued in response to the Applicants appeal brief, and is

therefore submitted after final action. Thus, the present Restriction Requirement is an improper Restriction Requirement after final action.

Furthermore, the present Restriction Requirement is an improper means for reopening prosecution after appeal. “[An] examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant’s brief or reply brief has been filed.” M.P.E.P. § 1207.04. There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-1303, 190 USPQ 425, 426-27 (CCPA 1976)). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* at 1303, 190 USPQ at 427.” M.P.E.P. § 1207.03(III).

In the present case, the Examiner has presented no new grounds of rejection by issuing a Restriction Requirement. The statutory basis for the rejection presented in the Final Office Action remain the same and the evidence relied upon in support of the rejection remains the same. Indeed, there is not even a change in the discussion of, or rationale in support of, the rejection. No additional grounds of rejection have been submitted to the original rejections presented in the Final Office Action have been submitted. Thus, the present Restriction Requirement does not present new grounds of rejection, and the Examiner may not rely on the present Restriction Requirement as a basis for reopening prosecution in the present matter.

Finally, the present Restriction Requirement is improper because there is no burden on the Examiner since all of the present claims have already been rejected at least two times prior to the election requirement. A proper Restriction Requirement requires that the inventions must be independent or distinct as claimed, and that there would be a serious burden on the examiner if restriction is not required. M.P.E.P. § 803. “If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinctive inventions.” *Id.*

In the present case, the Examiner has already examined all the claims at least twice in issuing the first and final Office Actions. Such is evidence to the fact that the Examiner has not

been seriously burdened in examining all of the claims on the merits and can continue to do so without serious burden. Furthermore, because the Examiner has not properly reopened prosecution, the claims have already been examined and no further examination is necessary in order to reply the Applicants appeal.

In view of the foregoing, the Applicants appeal should be reinstated and the Examiner should proceed with those options set forth in the M.P.E.P. § 1200 regarding responding to an appeal or reopening prosecution.

CONCLUSION

A reinstatement of Applicants appeal is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Tyler J. Barrett', with a stylized flourish at the end.

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